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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. PATTON

Appeal 2009-005515
Application 09/534,433
Technology Center 3700

Decided: September 30, 2009

Before: WILLIAM F. PATE, III, JENNIFER D. BAHR, and LINDA E.
HORNER, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

David L. Patton (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 12, 14, 18-23, 25, and 29-34. No other claims are pending in the application. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to limited edition stamps provided with indicia for verification. Spec. 1:4-5.

12. A limited edition official postal stamp comprising:

a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited edition official postage [*sic*] stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

The Rejections

The Examiner relies upon the following as evidence of unpatentability:

Burnham	US 4,884,828	Dec. 5, 1989
Guttag	US 5,120,089	Jun. 9, 1992
Martin	US 5,601,683	Feb. 11, 1997
Denenberg	US 5,673,338	Sep. 30, 1997

Schlauch

US 6,082,774

Jul. 4, 2000

Appellants seek review of the Examiner's rejections of claims 12, 14, 19-21, 23, 25¹, 30-32, and 34 under 35 U.S.C. § 102(b) as being anticipated by Gutttag, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Gutttag, Denenberg, and Schlauch; and claims 18, 22, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Gutttag, Denenberg, Schlauch, and either Martin or Burnham.²

SUMMARY OF DECISION

We AFFIRM.

ISSUE

The dispositive issue raised in this appeal is:

Has Appellant demonstrated that the Examiner erred in concluding that the combined teachings of Gutttag, Denenberg, and Schlauch render

¹ The Examiner's omission of claim 25 from the rejection in the Final Rejection (p. 2) and the Answer (p. 2) appears to have been an inadvertent error, in light of the Examiner's indication of claim 25 as rejected in the Office Action Summary of the Final Rejection, and the inclusion of claim 14, which contains substantially the same subject matter, in this rejection. Moreover, Appellant ostensibly understood that claim 25 was so rejected (App. Br. 1 and 3).

² Although Appellant identifies only a single ground of rejection, namely, the rejection of claims 12, 14, 18-23, 25, and 29-34 under 35 U.S.C. § 102(b) as being anticipated by Gutttag, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Gutttag, Denenberg, and Schlauch (App. Br. 3-4), it is apparent from Appellant's discussion of Martin and Burnham (App. Br. 7) that Appellant appreciated that some of the claims are rejected as being unpatentable over Gutttag, Denenberg, Schlauch, and either Martin or Burnham.

obvious a limited edition postal stamp provided with a first indicia that identifies the limited edition postal stamp as being one out of a predetermined number, and a second indicia which is not visible under normal viewing conditions, and which is not capable of being scanned for reproduction, for confirming that the limited edition postal stamp is a valid limited edition postal stamp?

Specifically, Appellant argues that Gutttag is not a limited edition postal stamp (App. Br. 4-5); Gutttag does not disclose, expressly or inherently, a second indicia for confirming that the stamp is a valid limited edition postal stamp (App. Br. 5); Denenberg does not remedy the deficiencies of Gutttag, because Denenberg stores encrypted information of microscopic anomalies as an index record, but does not disclose storing such index record on a limited edition postal stamp as a second indicia not visible under normal viewing conditions for confirming that the stamp is a valid limited edition postal stamp (App. Br. 6); and Schlauch fails to remedy the deficiencies of Gutttag and Denenberg, because Schlauch merely discloses a human readable marking 520 on the back of an envelope, but does not describe confirming that a stamp is a valid limited edition postal stamp (App. Br. 6).

Appellant argues all of the claims together as a group. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(vii) (2008), we select claim 12 as the representative claim to decide the appeal of the rejection of claims 12, 14, 19-21, 23, 25, 30-32, and 34, with claims 14, 19-21, 23, 25, 30-32, and 34 standing or falling with claim 12.

In contesting the rejection of claims 18, 22, 29, and 33, Appellant appears merely to rely on the arguments presented for claim 12 (App. Br. 7).

Thus, our conclusion as to claim 12 is dispositive as well for claims 18, 22, 29, and 33.

FACTS PERTINENT TO THE ISSUES

1. A limited edition stamp is a stamp that is one of only a limited number printed. *See* Spec. 1:20-24 (discussing limited edition items).
2. Appellant describes the second indicia 30 of the invention as not being capable of being scanned for reproduction, as described in U.S. Patent 5,919,730 to Gasper (Jul. 6, 1999), but being capable of being read under special viewing conditions. Spec. 5:16-18.
3. Accordingly, microdot patterns in which the individual microdots cannot be discriminated by observation of the document under conditions relevant to the normal use of the document are suitable for use as the second indicia. *See* Gasper, col. 6, ll. 15-32.
4. A “philatelic item” is a stamp, by itself, or on another piece, an envelope, or postal stationary. *See, e.g.,* Gutttag, col. 2, ll. 32-35; *Webster’s New World Dictionary* 1068 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984).
5. The worldwide interest in stamp collecting, or “philately,” renders many philatelic items very valuable, and thus subject to forgery, alteration, and theft. Gutttag, col. 1, ll. 10-39; Denenberg, col. 2, ll. 66-67.
6. Accordingly, it was extremely well known in the art, at the time of Appellant’s invention, to provide some means of identifying and authenticating such philatelic items. Gutttag, col. 1, ll. 40-42.

7. Means known in the art, at the time of Appellant's invention, for identifying a philatelic item, such as a postal stamp, as authentic include, *inter alia*, (1) placement of an identifying mark on the item by an expert (Guttag, col. 3, l. 54 to col. 4, l. 13) and (2) intentional placement of data or information in the form of a microdot pattern, such as a stamped design or logo, the details of which cannot be discerned by the naked eye, but can be observed under appropriate magnification, along with the storage of an archived record of the pattern details for use in authentication of the item (Denenberg, col. 1, ll. 32-35, col. 5, l. 56 to col. 6, l. 4, and col. 6, ll. 23-29).
8. The second means described in Fact 7 appears to be the same technique described in Appellant's Specification for the second indicia (Facts 2 and 3).
9. Denenberg also sets forth the premise that every object, regardless of its similarity to other objects under normal examination by the human eye, has unique intrinsic features at a microscopic level. Col. 3, ll. 10-14. Denenberg discloses exploiting those unique microscopic features as a unique identifier, or fingerprint, of that object, by reviewing the object at an appropriately high level of magnification, revealing a wealth of micro-features, and recording them for later retrieval and comparison with similarly located features on an item purporting to be the authentic object. Col. 1, ll. 8-14 and col. 5, ll. 5-10. In essence, according to Denenberg, every object has intrinsic unique micro-features that can be used to confirm the authenticity of the object.

10. Gutttag describes a stamp, which may be one of a limited number. Col. 1, ll. 33-34. Gutttag also describes placing on a stamp from a limited series a mark indicating the stamp's position in the series. Col. 3, ll. 60-63.
11. Denenberg likewise describes a valuable collectible item having a "series number" marked thereon (col. 5, l. 61) and "limited edition" prints (col. 10, l. 65).
12. Schlauch evidences that it was known in the art at the time of Appellant's invention to place limited edition markings, such as marking 520, which reads "887 OF 900 ISSUED," on philatelic items. Col. 17, ll. 47-49 and 56-57; fig. 5B.

PRINCIPLES OF LAW

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (internal citations and quotations omitted).

Rejections on obviousness grounds must be supported by "some articulated reasoning with some rational underpinning" to combine the known elements in the manner required in the claim at issue. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. We must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.*

While the demonstration of a teaching, suggestion, or motivation (the TSM test established by the Court of Customs and Patent Appeals) to combine known elements in order to show that the combination is obvious may be “a helpful insight,” it cannot be used as a rigid and mandatory formula. *Id.* at 418-19.

ANALYSIS

Appellant argues that Gutttag does not describe a limited edition stamp having a first indicia thereon identifying it as being one out of a predetermined number. App. Br. 4-5. As noted in our findings above, Gutttag describes a stamp, which may be one of a limited number. Fact 10. Gutttag further describes placing on a stamp from a limited series a mark indicating the stamp’s position in the series. *Id.* Thus, Gutttag may hint at or suggest a limited edition stamp, but does not explicitly describe a stamp that

is one of only a limited number printed, as contrasted with a stamp that is one of only a limited number in existence.

Nevertheless, even assuming that Appellant is correct that Gutttag does not describe a limited edition stamp, Denenberg and Schlauch evidence that limited edition philatelic items, such as envelopes and stamps, were well known at the time of Appellant's invention. Facts 11 and 12. Moreover, Schlauch evidences that it was well known at the time of Appellant's invention to place on philatelic items limited edition markings, identifying the philatelic item as one out of a predetermined number issued. Fact 12.

Denenberg sets forth the premise that every object, regardless of its similarity to other objects under normal examination by the human eye, has unique intrinsic features at a microscopic level. Fact 9. Denenberg discloses exploiting those unique microscopic features as a unique identifier, or fingerprint, of that object, by reviewing the object at an appropriately high level of magnification, revealing a wealth of micro-features, and recording them for later retrieval and comparison with similarly located features on an item purporting to be the authentic object. *Id.* In essence, according to Denenberg, every object has intrinsic unique micro-features that can be used to confirm the authenticity of the object. *Id.* In accordance with that theory, the Examiner finds that every postal stamp inherently comprises indicia which are not visible under normal viewing conditions, but are viewable under an appropriately high level of magnification, for confirming that a limited edition postal stamp is authentic. Ans. 4.

Moreover, even discounting, *arguendo*, Denenberg's premise as speculative, we conclude that the combined teachings of Gutttag, Denenberg, and Schlauch are sufficient to establish that it would have been obvious to a

person of ordinary skill in the art to place a second indicia as called for in claim 12 on a limited edition postal stamp. It was well known in the art that philatelic items, such as stamps, are subject to forgery, alteration, and theft. Fact 5. To address this problem, it was extremely well known in the art, at the time of Appellant's invention, to provide some means of identifying and authenticating such philatelic items. Fact 6. One means known in the art at the time of Appellant's invention for identifying a philatelic item, such as a postal stamp, as authentic is the intentional placement of data or information in the form of a microdot pattern, such as a stamped design or logo, the details of which cannot be discerned by the naked eye, but can be observed under appropriate magnification, along with the storage of an archived record of the pattern details for use in authentication of the item. Fact 7. Accordingly, it would have been obvious to a person of ordinary skill in the art to provide such a microdot pattern on a limited edition postal stamp as a means of authentication. This microdot pattern appears to be the same technique described in Appellant's Specification for the second indicia. Fact 8.

In light of the above, a limited edition postal stamp having first and second indicia as called for in claim 12 is nothing more than the predictable combination of elements known in the art of philately according to their established functions.

Appellant's arguments as to the deficiencies of each of Gutttag, Denenberg, and Schlauch attack each of the references in isolation, rather than as combined by the Examiner, and thus are not persuasive to show that the claimed subject matter would not have been obvious. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (nonobviousness cannot be

established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures).

CONCLUSIONS

Appellant has not demonstrated that the Examiner erred in concluding that the combined teachings of Guttag, Denenberg, and Schlauch render obvious a limited edition postal stamp provided with a first indicia that identifies the limited edition postal stamp as being one out of a predetermined number, and a second indicia which is not visible under normal viewing conditions, and which is not capable of being scanned for reproduction, for confirming that the limited edition postal stamp is a valid limited edition postal stamp. Therefore, we sustain the Examiner's rejection of claim 12, and claims 14, 19-21, 23, 25, 30-32, and 34, which fall with claim 12, on that basis. In merely relying on the arguments presented for claim 12, Appellant likewise has not demonstrated error in the Examiner's rejection of claims 18, 22, 29, and 33. We sustain that rejection as well.

DECISION

The Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2009-005515
Application 09/534,433

hh

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